

Practitioner's Docket No.: 1135.31

**PATENTS**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Re Application of: John F. Baxter, Jr.

Serial No.: 10/604,603

Filed: 08/04/2003

For: **Method of Embedding Product**  
**Information on a Digital Versatile Disc**

Art Unit: **Unassigned**

Director: **Unknown**

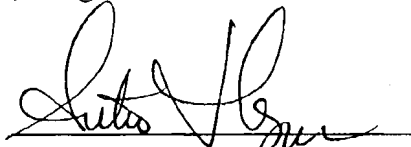
Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**TRANSMITTAL OF PETITION TO MAKE SPECIAL**

1. Transmitted herewith is a Petition to Make Special for this application.

**FEE DEFICIENCY**

2. If any additional extension and/or fee is required, charge Account No. 500745.

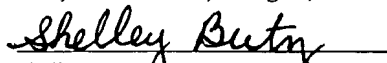
  
**Signature of Practitioner**

Reg. No. 41,849  
Tel. No.: (727) 507-8558

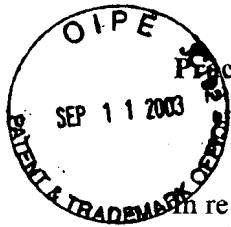
Anton J. Hopen  
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**CERTIFICATE OF MAILING**  
(37 C.F.R. § 1.8)

I HEREBY CERTIFY that this correspondence is being deposited with the United States Postal Service by First Class Mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Arlington, VA 22313-1450 on September 8, 2003.

  
Shelley Butz

(Transmittal—page 1)



Practitioner's Docket No. 1135.31

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: John F. Baxter, Jr.                      Group No.: Not yet assigned  
Application No.: 10/604603                      Examiner: Not yet assigned  
Filed: August 04, 2003  
For: METHOD OF EMBEDDING PRODUCT INFORMATION ON A  
DIGITAL VERSATILE DISC

Mail Stop Petitions  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

PETITION TO MAKE SPECIAL FOR NEW APPLICATION  
UNDER M.P.E.P. section 708.02, VIII

1. Petition

Applicant hereby petitions to make this new application, which has not received any examination by the Examiner, special.

2. Claims

All the claims in this case are directed to a single invention. If the Office determines that all the claims presented are not obviously directed to single invention, then applicant will make an election without traverse as a prerequisite to the grant of special status.

3. Search

Undersigned attorney made a search of:

Field of search:            Class 348, subclass 14.04  
                                  Class 386, subclasses 15 and 126  
                                  Class 707, subclass 104.1  
                                  Class 725, subclasses 24, 50, and 60

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Petition to make special  
In re John Baxter

Ser. No. 10/604,603  
Filing Date: August 4, 2003

Examiner: Not yet assigned  
Group Art: Not yet assigned

**Patent References:**

<u>Inventor</u>	<u>Patent Number</u>	<u>Year</u>
Kamatani	5,587,981	1996
Mueller, et al.	5,900,098	1998
Tognazzini	5,959,946	1999
Page	6,116,652	2000
Wu et al.	6,263,344	2001
Oh et al.	6,320,840	2001
Dinallo et al.	5,929,857	1999
Jeong	6,141,004	2000
Brodersen et al.	6,453,459	2002
Shastri et al.	2001/0003214	
Roebuck	2002/0026388	
Lamkin	2002/0078144	
Delpuch	2002/0184648	
Ogawa et al.	2003/0026937	
Hunter	2003/0028888	
Hunter	2003/0061607	
Hunter	2002/0124251	
Brodensen et al.	2003/0005442	
Siedel	WO98/38637	

**4. Copy of references**

There is submitted herewith a copy of the references deemed most closely related to the subject matter encompassed by the claims.

Also attached is Form PTO-1449. (PTO/SB/08A).

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**5. Detailed discussion of the references**

There is submitted herewith a detailed discussion of the references, which discussion particularly points out how the claimed subject matter is distinguishable over the references. Copies of references already filed and of record are not included herewith. MPEP §708.02(VIII)(D).

Applicant claims a method of presenting purchasing information within a cinematic feature on digital versatile disc comprising steps of: (1) identifying an object within the feature sought to be sold, (2) capturing at least one frame of the feature showing the object, (3) graphically modifying the frame to enhance the presence of the object, (4) creating a menu interface with the frame, (5) creating a selectable menu button defined by the object, (6) creating a second menu having purchasing information for the object, the second menu displayed responsive to the activation of the button.

Section 102 of the United States Patent Laws provides in relevant part:

A person shall be entitled to a patent unless . . . the invention was known or used by others in this country, or patented or described in a written publication in this or a foreign country . . .

None of references obtained in the prior art search disclose or describe Applicant's invention.

Section 103 of the United States Patent Laws provides in relevant part:

A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

No combination of references obtained in the prior art search teaches or suggest Applicant's invention.

United States Patent Publication Nos. 2002/0124251, 2003/0028888, and 2003/0061607 to *Hunter et al.* describe systems and methods for playing optical discs containing product promotion material to be played in unison with a second optical disc containing entertainment material. However, the *Hunter et al.* applications vary greatly in that they do not describe, suggest, or contemplate the interactive nature of Applicant's method. Specifically, the *Hunter et al.* applications do not allow viewer control since the advertising content is displayed in response to a predetermined algorithm. Additionally, the *Hunter et al.* applications require a proprietary set top box. Applicant describes a (Petition to Make Special for New Application under M.P.E.P. section 708.02, III—page 3 of 5)

method whereby the viewer has the ability to identify products within the movie itself, not on a second disc or requiring an additional player, which can then be identified in a freeze

frame and the necessary information is disseminated via interactive menus. Accordingly, almost all of the elements of Applicant's claims are absent from the *Hunter et al.* patent applications.

United States Patent No. 6,453,459 to *Brodersen et al.* and related Patent Application Publication No. 2003/0005442 to *Brodersen et al.* both describe a system and method for creating DVD menus using a graphical authoring interface thus relieving the author from the constraints of the DVD specification (col. 3, lines 26-30). The patent and application do not discuss the application of interactive DVD menus for the purpose of identifying consumer products within a movie, nor gaining purchasing information for said products, as claimed by Applicant.

United States Patent No. 5,929,857 to *Dinallo et al.* describes a method and apparatus for creating a graphic user interface from a DVD (col. 3, 29-32). In contrast, the '857 patent does not describe, suggest, or teach the application of the graphic user interface for the application or method of identifying and selecting an item placed within a movie. Instead the '857 patent describes a means by which a graphic user interface is generated by information in the data stream and is constructed during playback from a database of predefined images which depict controls, buttons and other graphic images (col. 3, lines 26-29). Applicant's claimed method generates its graphic interface from the images of the movie itself, by recording a time code value of at least one frame, rather than a predetermined database. Consequently, at least elements 1, 3, 6 are absent from the '857 patent.

United States Patent No. 6,141,004 to *Jeong* describes a DVD player which avoids user-interface error by reducing the load of the system controller by bifurcating the operations of the DVD player (col. 4, lines 66-67 and col. 5, lines 1-3). The patent describes a method wherein a system controller controls the overall operation of the DVD player and an audio/video decoder decodes the DVD bit stream data into the corresponding audio and video data (col. 5, lines 3-10). This places a lesser burden on the system controller and allows for the processing of highlighting information in menus since the system controller no longer needs to check every item of information on the control pack in order to control the audio/video decoder (col. 4, lines 56-59). As a result, the '004 patent describes the method by which error free user menus are achieved, not how they are applied. The '004 patent does not describe or suggest the limitations of Applicant's claimed invention.

Applicant believes the remaining references to be less relevant to the patentability of Applicant's invention. However, a summary of each remaining reference is provided to illustrate the field of search. U.S. Patent No. 5,587,981 to *Kamatani* describes a reader that is able to read both CD and DVD media by examining the disk and adjusting the system to accommodate the type of disc being used.

(Petition to Make Special for New Application under M.P.E.P. section 708.02, III—page 4 of 5)

U.S. Patent No. 5,900,098 to *Mueller et al.* describes the bonding of dissimilar discs using a heat activated bonding material which is applied to the non-data carrying

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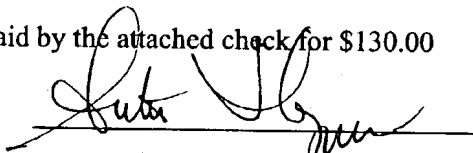
Group Art: Not yet assigned

side of a disc. U.S. Patent No. 5,959,946 to *Tognazzi* describes an optical disc with two distinct data regions, one which is recorded in the manufacturing process and a second which is blank and recordable allowing data to be added to the disc after manufacture. U.S. Patent No. 6,116,652 to *Page* describes an educational instructional unit. Although the preferred embodiment of the invention is in paper form other embodiments are described including a hybrid of computer and interactive television. U.S. Patent No. 6,263,344 to *Wu et al* teaches a method of producing a video CD on which language such as JAVA and HTML can be translated and processed with minimal computing power. U.S. Patent No. 6,320,840 to *Oh et al.* which describes a hybrid optical disc containing both CD and DVD readable media.

U.S. Patent Publication No. 2001/0003214 to *Shastri et al.* describes the marriage of interactive television with hypertext linking to external files via the internet. Links are embedded in a closed-caption frame and allows the viewer to activate the link to obtain information relating to the presentation. U.S. Patent Publication No. 2002/0078144 to *Lamkin* shows a combination of local content, located on a CD or DVD, and media supplied by a computer network to provide a composite presentation. Publication No. 2002/0184648 to *Delpuch* describing the production and distribution of interactive video magazines. U.S. Patent Publication No. 2003/0026937 to *Ogawa et al.* shows a method of producing both CD and DVD content on a single side of an optical disc. Finally, International Publication No. WO98/38637, issued to *Siedel* describes a means of recognizing and addressing dual sided CDs and DVDs.

#### 6. Fee

The fee required by 37 C.F.R. 1.17(i) is to be paid by the attached check for \$130.00

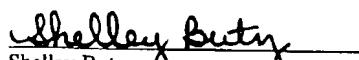
  
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(Petition to Make Special for New Application under M.P.E.P. section 708.02, III—page 5 of 5)

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